

REMARKS/ARGUMENTS

Claims 1, 4-8, 18 and 27-29 are now pending in this application. Claims 2, 3, 9-17 and 19-26 have been cancelled. Claims 27-29 are newly added. Claims 1, 18 and 27 are independent claims. Claims 1 and 18 have been amended.

Claim Rejections – 35 USC § 102(b)

Claims 1, 4 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Heil et al., United States Patent Number: 6,173,374 (hereinafter: Heil). (Pending Office Action, Page 2). Applicants respectfully traverse these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claim 1 recites elements that have not been disclosed, taught or suggested by Heil. For example, Claim 1 generally recites: “the common transport message being compliant with a Fibre Channel General Services Common Transport version 3 (FC-GS-3) Protocol.” (Present Application, Claim 1; Page 4, Paragraph 0010; and Page 7, Paragraph 0018). The Patent Office clearly acknowledges that Heil ***does not*** teach, disclose or suggest the above-referenced elements of the claimed invention. (Pending Office Action, Page 6). Further, Claim 1 generally recites: “the bus message passing request being a Fusion Message Passing Technology request.” (Present Application, Claim 1; Page 4, Paragraph 0010; and Page 7, Paragraph 0018). Again, the Patent Office has clearly acknowledged that Heil ***does not*** teach, disclose or suggest the above-referenced elements of the claimed invention. (Pending Office Action, Page 8). Given the Patent Office’s acknowledgement that nowhere in Heil are the above-reference terms disclosed, taught or suggested, Applicants point out that under *Lindemann*, a prima

facie case of anticipation has not been established for independent Claim 1. Thus, based on the above rationale, the rejection under this section against independent Claim 1 should be withdrawn. Further, the rejection under this section against dependent Claims 4 and 6 (which depend on independent Claim 1) should also be withdrawn.

Claim Rejections – 35 USC § 103(a)

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex SLI Architecture. (Pending Office Action, Page 7). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Infiniband Storage. (Pending Office Action, Page 7). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnywhere and Emulex SLI Architecture. (Pending Office Action, Page 8). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of LSI Logic's Fusion-MPT. (Pending Office Action, Page 9). Applicants respectfully traverse these rejections.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (emphasis added). Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.” (emphasis added) *In re Fine*, 837 F. 2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that the claims rejected under this section include elements that have not been disclosed, taught or suggested by any of the references cited by the Patent Office, either alone or in combination.

Independent Claims 1, 18 and 27 of the present invention each generally recite:

“utilizing the modified common transport message for
updating and configuring the remote host bus adapter.”

In the present invention, the modified common transport message is utilized for allowing updating and configuring of a remote HBA by a local HBA. (Present

Application, Page 5, Paragraph 0010 and Page 6, Paragraph 0013). None of the above cited references, either alone or in combination, teach, disclose or suggest the above-referenced elements. For example, Heil focuses on intercommunication between clustered I/O nodes (Heil, Abstract), while the present invention focuses on administration and configuration of remote HBAs. (Present Application, Page 5, Paragraph 0010).

Independent Claims 1, 18 and 27 of the present invention each generally further recite:

“wherein the system/method is configured for/allows for in-band and out-of-band remote host bus adapter management.”

The system of the present invention allows for both in-band and out-of-band remote host bus adapter management. (Present Application, Page 4, Paragraph 0010; Page 5, Paragraph 0011; Page 6, Paragraph 0014; Page 7, Paragraph 0017). Cited references, such as Emulex HBAnywhere or Emulex SLI Architecture, do not allow for out-of-band remote host bus adapter management. Further, neither Heil, nor any of the above cited references, either alone or in combination, teach, disclose or suggest the above-referenced elements.

Further, there would have been no motivation for one of ordinary skill in the art at the time of the present invention to look to Heil or implement Heil with either Emulex HBAnywhere or LSI's Fusion-MPT technology to arrive at the present invention. The present invention focuses on configuration and updating of remote HBAs, (Present Application, Page 5, Paragraph 0010) while Heil proposes a method of intercommunication between clustered I/O nodes. (Heil, Abstract). Therefore, it would not have been obvious for one of ordinary skill in the art at the time of the present invention to look to, modify or combine Heil with the other cited references to arrive at the claimed invention.

Based on the above rationale, there would have been no motivation for one of ordinary skill at the time of the present invention to combine the above-cited references.

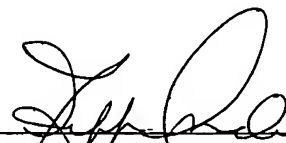
"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

The Patent Office has proceeded to *impermissibly* use the present patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention and, in light of the current amendments, has failed to make a *prima facie* case of obviousness against claims 1, 18, and 27. Thus, claims 1, 18, and 27 should be allowed over the prior art of record. Further, Claims 4-8 (which depend from Claim 1) and Claims 28 and 29 (which depend from claim 27) should also be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

Respectfully submitted on behalf of
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